



Question Q217

National Group: United States

Title: The patentability criteria for inventive step / non-obviousness

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Questions

I. Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

Level of inventive step / non-obviousness

1. What is the standard for inventive step / non-obviousness in your jurisdiction?
How is it defined?

Under 35 U.S.C. § 103, a patent cannot be obtained “if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.” The last sentence was added specifically to prevent a requirement for a “flash of genius” in order to find a claim non-obvious. However, other than this last sentence, the statute itself provides little guidance for determining whether a claim is obvious. In *Graham v. John Deere Co.*, 383 U.S. 1 (1966), the Supreme Court indicated that the following factual inquiries must be evaluated in making this determination:

- (a) Determining the scope and content of the prior art;
- (b) Ascertaining the differences between the claimed invention and the prior art; and
- (c) Resolving the level of ordinary skill in the pertinent art.

When presented, objective evidence of non-obviousness known as “secondary considerations,” must be evaluated, as discussed in answer to subsequent questions.

2. Has the standard changed in the last 20 years? Has the standard evolved with the technical / industrial evolution of your jurisdiction?

Perhaps the most important change over the last 20 years has been the U.S. Supreme Court’s decision in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). In this decision, the Supreme Court rejected the longstanding “teaching, suggestion or motivation” test (TSM Test) of the Court of Appeals for the Federal Circuit, the intermediate level appellate court that hears all appeals of patent cases, as the exclusive test for determining obviousness. Under the TSM test, a specific teaching, suggestion or motivation in the prior art was required in the prior art in order to be able to combine features of prior art references in order to show obviousness. However, in *KSR*, the Supreme Court rejected a rigid application of the TSM test in favor of a more flexible approach to obviousness. Among the many rationales for finding a claim obvious, any reason to combine features of prior art references is sufficient to create a rebuttable presumption of obviousness (*prima facie* obviousness). There is no requirement that such a reason have anything to do with the technical problem being solved by the invention.

Because the statute and underlying factual inquiries require consideration of the level of ordinary skill in the pertinent art, the standard has been sufficiently flexible to keep up with technical / industrial evolution.

3. Does your patent-granting authority publish examination guidelines on inventive step / non-obviousness? If yes, how useful and effective are the guidelines?

The USPTO has published examination guidelines on obviousness determinations in the Manual of Patent Examination Procedure (MPEP). See MPEP §§ 2141-2146. The current guidelines at MPEP § 2141 *et seq.* provide various rationales for establishing *prima facie* obviousness, but do not provide any examples of claims that are not *prima facie* obvious. The USPTO recently published proposed guidelines applying *KSR* for the obviousness determination for Examiners to follow during examination. 75 FR 53643 (Sep. 1, 2010); http://www.uspto.gov/patents/law/exam/ksr_training_materials.jsp. Eventually, these guidelines are expected to be included in the MPEP. The proposed guidelines provide a thorough analysis of the decisions of the Federal Circuit following the *KSR* decision, and provide examples of claims that are both obvious and non-obvious. As such, these guidelines can be quite useful to Examiners, applicants and even the courts.

4. Does the standard for inventive step / non-obviousness differ during examination versus during litigation or invalidity proceedings?

The same legal standard for obviousness is applied at the USPTO as in litigation. Nevertheless, a difference in the application of the standard results from different levels of proof required examination or in litigation. In litigation, granted patents presently have a presumption of validity under 35 U.S.C § 282 requiring a challenger to prove that a patent is obvious under a clear and convincing evidentiary standard. Since a pending claim is not presumed valid during examination by the USPTO, whether examination is being conducted for an original application, a reissue application or a reexamination proceeding, the USPTO will evaluate a claim for *prima facie* obviousness, which can then be rebutted by the applicant. In litigation, when the validity of a granted claim is being evaluated, the burden to establish obviousness is greater and never leaves the challenger.

Construction of claims and interpretation of prior art

5. How are the claims construed in your jurisdiction? Are they read literally, or as would be understood by a person skilled in the art?

In the U.S., claims are construed as they would be by one of ordinary skill in the art, first in view of the intrinsic evidence (i.e. the specification and the prosecution history), then in view of the extrinsic evidence (i.e. any other information). In particular, the specification and prosecution history are examined first to determine how one of ordinary skill in the art would construe the terms used in the claims. If such intrinsic evidence proves to be insufficient in adequately construing the claim terms, extrinsic evidence may then be used to show what one of ordinary skill in the art would understand the claim terms to mean. See *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (*en banc*).

6. Is it possible to read embodiments from the body of the specification into the claims?

As discussed above, the claims are construed in view of the specification. While the claims will not necessarily be limited to those embodiments disclosed in the specification, those embodiments will be used to help interpret the meaning of the terms used in the specification. "Reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." *In re Prater*, 415 F.2d 1393, 1404-05, (CCPA 1969). However, if the original specification or the comments of the applicant during prosecution manifests a clear intent to limit a term or phrase to only a single meaning or embodiment, the courts may restrict the claim to such meaning or embodiment.

7. How is the prior art interpreted? Is it read literally or interpreted as would be understood by a person skilled in the art? Is reliance on inherent disclosures (aspects of the prior art that are not explicitly mentioned but would be understood to be present by a person skilled in the art) permitted?

Similar to claim terms, the prior art is interpreted as would be understood by a person of ordinary skill in the art. Reliance on inherent disclosures of the prior art is both permitted and required. Inherency, however, requires that the missing descriptive material is "necessarily present," not merely probably or possibly present, in the prior art.

Moreover, there is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure, but only that the subject matter was in fact inherent in the prior art reference.

8. Do the answers to any of the questions above differ during examination versus during litigation?

During examination, patent claims are given the broadest reasonable construction in light of the specification as understood by a person having ordinary skill in the art. Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation during examination reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. However, the broadest reasonable interpretation of the claims must also be consistent with the interpretation that a person having ordinary skill in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359 (Fed. Cir. 1999).

In contrast, during litigation terms are given their "ordinary and customary meaning" unless a different definition is apparent from the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (*en banc*).

Combination or modification of prior art

9. Is it proper in your jurisdiction to find lack of inventive step or obviousness over a single prior art reference? If yes, and assuming the claim is novel over the prior art reference, what is required to provide the missing teaching(s)? Is argument sufficient? Is the level of the common general knowledge an issue to be considered?

A claim may be found obvious over a single prior art reference where the missing teaching(s) of that reference would have been obvious to a person of ordinary skill in the art at the time of the invention. See e.g., *Boston Scientific Scimed, Inc. v. Cordis Corp.*, 554 F.3d 982, 990-991 (Fed. Cir. 2009). The prior art reference need not expressly suggest the missing teaching or specifically set forth the motivation for modifying the disclosed teachings to encompass that what is missing. See *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 401 (2007) (An obviousness analysis "need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ."). The motivation to modify the single prior art reference can come from "any need or problem known in the field of endeavor at the time of the invention." *Id.* at 402. Market demands, common knowledge, common sense, and creative steps that a person of ordinary skill in the art would likely use at the time of the invention are considered. *Id.* at 419-420.

There are several ways to show that it would have been obvious to modify the single prior art reference in a manner that supplies the missing teaching. These include: (1) showing that the missing teaching was an obvious solution to a known problem at the time of the invention, *id.* at 420; (2) demonstrating that the missing teaching was a predictable variation of components or processes known to one of ordinary skill in the art, *id.* at 417; (3) showing that the missing teaching was a feature known to have been used to improve similar devices or processes in the same way as recited in the claim, see *Ecolab, Inc. v.*

FMC Corp., 569 F.3d 1335 (Fed. Cir. 2009); and (4) showing that there was a design need or market pressure to solve a problem and the missing teaching was one of a finite number of identified, predictable solutions to the problem, see *Bayer Schering Pharma AG v. Barr Labs., Inc.*, 575 F.3d 1341, 1347 (Fed. Cir. 2009).

10. What is required to combine two or more prior art references? Is an explicit teaching or motivation to combine required?

To show obviousness of a claim based on a combination of two or more prior art references the scope and content of the prior art must be determined, the differences between the prior art and the claim must be ascertained, and the level of ordinary skill in the pertinent art must be resolved. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). If known and presented, objective evidence of non-obviousness, such as evidence of commercial success, long-felt but unsolved needs, the failure of others to solve the problem, and unexpected results achieved by the claimed invention, must also be considered. The question of obviousness is then resolved on the basis of these factual determinations.

Against this backdrop, combining two or more prior art references to render a claim obvious requires a showing of which claim elements are disclosed by which of the two or more prior art references. Teachings that are missing from one reference may be provided by another reference in the combination or may be shown to have been obvious as discussed above in response to question 9. There must also be a showing of a reason or motivation to combine the teachings of the references that render the claim obvious.

Explicit teachings or motivations in the prior art are not required to demonstrate that the claim would have been obvious over the combination. As discussed above in response to question 9, predictability, marketplace incentives, common sense, and common knowledge of a person skilled in the art can provide the apparent reason for one of ordinary skill in the art to make the claimed combination.

11. When two or more prior art references are combined, how relevant is the closeness of the technical field to what is being claimed? How relevant is the problem the inventor of the claim in question was trying to solve?

The relationship between the technical fields of the claimed invention and the prior art is relevant in determining whether the prior art combination renders the claim obvious. Prior art asserted in an obviousness combination should be analogous to the claimed invention. *KSR*, 550 U.S. at 417, 420. Analogous art can be either art from the same field of endeavor, or art that is reasonably pertinent to the particular problem of the invention, regardless of the field of the inventor's endeavor. *Innovention Toys, LLC, V. MGA Entertainment, Inc.*, (No. 2010-1290) (Fed. Cir. Mar. 21, 2011). Indeed, the recognized problem in the claim's field of the endeavor can provide an apparent reason for one of skill to combine prior art references. *KSR*, 550 U.S. at 420. Conversely, arguments that the proposed combinations rely on non-analogous prior art may be used to defeat the position that the claimed combination would have been obvious. However, teachings in technical fields outside of that of the claim may be relevant where it is shown that work in the claim's field of endeavor prompted predictable variations of it for use in the other fields. *KSR*, 550 U.S. at 417 ("When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in

the same field or a different one.”).

With regard to the second question, the problem that the inventor attempted to solve may be only one of many addressed by his or her patent. “The question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art.” *Id.* at 420. As such, obviousness cannot be avoided solely because the inventor’s claim addresses a problem different from that of the combined prior art where there existed a need or problem known in the field of endeavor at the time of the invention.

12. Is it permitted in your jurisdiction to combine more than two references to show lack of inventive step or obviousness? Is the standard different from when only two references are combined?

Two or more prior art references can be combined to show obviousness of a claim. See e.g., *Commonwealth Scientific and Indus. Research Org. v. Buffalo Technology (USA), Inc.*, 542 F.3d 1363 (Fed. Cir. 2008) (finding obviousness over three prior art references); *KSR*, 550 U.S. at 420 (“Common sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.”). The standard is the same regardless of whether the obviousness position is based on one or more prior art references. See responses to questions 9-11.

13. Do the answers to any of the questions above differ during examination versus during litigation?

Whether obviousness is determined during litigation or examination, the responses do not, in general, differ. Indeed, as noted above in response to question 3, the USPTO has proposed guidelines and training materials on the issue of obviousness that suggest that determinations of obviousness during examination should be consistent to those applied during litigation.

Differences may lie in how the basis of the obviousness is demonstrated. For example, during examination, evidence of motivation may be presented through Examiner argument, or by the patentee or third party requester in reexamination proceedings. However, the arguments must demonstrate concrete factual support in the evidentiary record and cannot merely cite its own undocumented understanding of what the prior art shows or suggests. See *In re Zurko*, 258 F.3d 1379 (Fed. Cir. 2001); *In re Sang Su Lee*, 277 F.3d 1338, 1345 (Fed. Cir. 2002) (vacating a USPTO obviousness rejection because the Examiner and Board of Appeals failed to provide any substantive reason as to the motivation to combine two references). Conclusory obviousness positions are also discouraged during litigation. However, evidence to support a motivation to combine may be presented through record evidence of prior art references and witness testimony where the credibility of the proffered evidence may be better considered.

Technical Problem

14. What role, if any, does the technical problem to be solved play in

determining inventive step or non-obviousness?

For purposes of determining obviousness, the particular problem with which the inventor was concerned may be used to identify applicable prior art that is pertinent to that problem. Prior art may also be in the general field of the inventor's endeavors. In determining obviousness, neither the particular motivation to make the claimed invention nor the problem the inventor is solving controls. The proper analysis is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts. One such fact to consider may optionally be the prior art elements that address the same problem the inventor was attempting to solve. It is erroneous, however, to limit the analysis to prior art addressing the same problem.

15. To what degree, if any, must the technical problem be disclosed or identified in the specification?

There is no requirement that the technical problem be disclosed or identified in the specification. If the invention lies in discovering the source of a problem, then inventors must provide evidence substantiating the allegation. This evidence may be presented either by way of affidavits or declarations, or by way of a clear and persuasive assertion in the specification.

Advantageous effects

16. What role, if any, do advantageous effects play in determining inventive step or non-obviousness?

As noted in the U.S. Group response to Q209, "bald statements of advantages and results in apparatus claims are not given weight in claim construction under U.S. law. However, a resourceful claim drafter may be able craft an apparatus claim that directly claims an advantage or result. Similarly, such limitations may be incorporated into processes or method of use claims." But, the advantageous effects need not be claimed to be considered as evidence to rebut a *prima facie* determination of obviousness.

Generally, when advantageous effects or results are known in the prior art or are predictable from the prior art, then the advantageous effect will not be sufficient to rebut a *prima facie* obviousness rejection, and may be evidence of obviousness. However, if the advantageous effect or result is unexpected or unexpectedly superior in view of the prior art, then such effect is a factor to be weighed in favor of a finding of non-obviousness. But, this factor is not dispositive. In the case of superior effects, Applicants must show that the advantageous results were greater than those which would have been expected from the prior art to an unobvious extent, and that the results are of a significant, practical advantage. Evidence of unobvious or unexpected advantageous properties, such as superiority in a property the claimed compound shares with the prior art, can rebut *prima facie* obviousness. For example, "[e]vidence that a compound is unexpectedly superior in one of a spectrum of common properties . . . can be enough to rebut a *prima facie* case of obviousness." *In re Chupp*, 816 F.2d 643, 646, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987).

17. Must the advantageous effects be disclosed in the as-filed specification?

No. However, for the advantageous effects to be added to the patent claims by amendment there must be support in the as-filed specification for such effects.

18. Is it possible to have later-submitted data considered by the Examiner?

Yes. Evidence as to the advantageous effects may be submitted during examination of the application by way of affidavits or declarations, and may include experimental test results.

19. How "real" must the advantageous effects be? Are paper or hypothetical examples sufficient?

The advantageous effects must be real and not hypothetical examples. Evidence of unexpected properties may be in the form of a direct or indirect comparison of the claimed invention with the closest prior art which is commensurate in scope with the claims.

20. Do the answers to any of the questions above differ during examination versus during litigation?

Generally, there is no difference. During examination, evidence is brought forth by the applicant to rebut an Examiner's initial *prima facie* rejection of obviousness. Likewise, during litigation, evidence of unexpected advantageous effects, properties or results may be presented to rebut evidence and arguments presented by an accused infringer on the obviousness of an issued patent.

Teaching away

21. Does your jurisdiction recognize teaching away as a factor in favor of inventive step / non-obviousness? Must the teaching be explicit?

Teaching away is recognized as a factor in determining non-obviousness. A prior art reference must be considered in its entirety, that is, all the teachings of the reference as a whole, including portions that would lead away from the claimed invention. The teaching away must be explicit and must criticize, discredit or otherwise discourage the solution claimed. The prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of the alternatives.

22. Among the other factors supporting inventive step / non-obviousness, how important is teaching away?

Teaching away is an important factor in determining non-obviousness. The teaching away found in the prior art reference(s) relied upon for an obviousness rejection is often sufficient to rebut a *prima facie* obviousness rejection. It is difficult for an obviousness rejection to be upheld based on a reference that criticizes, discredits or otherwise discourages the claimed invention.

23. Is there any difference in how teaching away is applied during examination versus in litigation?

The concept of teaching away is applied the same way in examination as it is in litigation. However, the interpretation of the breadth of the claims is different in prosecution, where the broadest reasonable interpretation standard is used, versus litigation, where the claims can be interpreted more narrowly in view of the specification and file history and sometimes to preserve the validity of the claims.

Secondary considerations

24. Are secondary considerations recognized in your jurisdiction?

Yes.

25. If yes, what are the accepted secondary considerations? How and to what degree must they be proven? Is a close connection between the *claimed* invention and the secondary considerations required?

There are several possible secondary considerations: (1) commercial success, (2) long felt but unsolved needs, (3) failure of others, (4) skepticism of experts, (5) praise by others, (6) teaching away by others, (7) unexpected results, (8) recognition of a problem, (9) copying, (10) licensing, and (11) near-simultaneous invention. Evidence pertaining to secondary considerations must be taken into account whenever present; however, it does not necessarily control the obviousness conclusion.

There must be a “nexus” or a close connection between the claimed invention and the evidence supporting the secondary consideration. For example, commercial success must be shown to have resulted because of a claimed feature of the invention. While, the evidence should sufficiently support the breadth of the claims, the evidence does not need to support every disclosed embodiment or species set forth in the claims. For example, when considering whether the evidence is commensurate in scope with the claimed invention, the applicant does not have to show evidence of unexpected results over the entire range of properties possessed by a chemical compound or composition. A showing of unexpected results for a single member of a claimed subgenus, or a narrow portion of a claimed range would be sufficient to rebut an obviousness rejection if a skilled artisan could ascertain a trend in the exemplified data that would allow him to reasonably extrapolate the results.

26. Do the answers to any of the questions above differ during examination versus during litigation?

The answers do not differ; however, it is generally easier to prove secondary considerations during examination where you have only an examiner to convince versus litigation where the evidence provided to support secondary considerations is going to be scrutinized by the party opposing the patent.

Other considerations

27. In addition to the subjects discussed in questions 4 - 26 above, are there other

issues, tests, or factors that are taken into consideration in determining inventive step / non-obviousness in your jurisdiction?

If yes, please describe these issues, tests, or factors.

Yes, there are several very specific legal issues that relate to obviousness; however, the important concepts related to obvious are outlined elsewhere in this answer.

Test

28. What is the specific statement of the test for inventive step/non-obviousness in your jurisdiction? Is there jurisprudence or other authoritative literature interpreting the meaning of such test and, if so, provide a brief summary of such interpretation.

There are three essential requirements to support a *prima facie* case of obviousness. First, as the U.S. Supreme Court held in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), "a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. ... it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does... because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *Amgen Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991). Lastly, the prior art references must teach or suggest all the limitations of the claims. *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970).

29. Does such test differ during examination versus during litigation?

The test for determining obviousness during examination and litigation is the same. The difference is in the amount of evidence needed to establish obviousness of the claims. The U.S. Patent Act provides that "[a] patent shall be presumed valid" and that "[t]he burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity." 35 U.S.C. § 282. Accordingly, during litigation, a case of obviousness must be proven by "clear and convincing evidence." See, e.g., *Am. Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1359-60 (Fed. Cir. 1984). This is a heightened standard of proof that is not used during examination, which instead uses a "preponderance of the evidence" standard. Please note, however, the question of the standard of proof in litigation is currently being examined by the U.S. Supreme Court in *Microsoft Corp. v. i4i Limited Partnership and Infrastructures for Information Inc.*, No. 10-290, and may change soon.

Patent granting authorities versus courts

30. If there are areas not already described above where the approach to inventive step / non-obviousness taken during examination diverges from that taken by courts, please describe these areas.

Differences between the courts and the USPTO with regard to substantive issues

involving obviousness already have been addressed. A further significant difference is procedural, involving presumptions and burdens of proof.

Section 282 of the U.S. Patent Statute provides that “[a] patent shall be presumed valid.” 35 U.S.C. § 282. This presumption has for some time placed on a challenger a burden of proving invalidity by “clear and convincing evidence.” The case of *Microsoft Corporation v. i4i Limited Partnership* will be decided by the U.S. Supreme Court in 2011 and is likely to give guidance as to whether this is the appropriate standard (as opposed to a mere “preponderance of evidence”) or whether some other standard should apply, especially where the prior art had not been considered by the USPTO during examination. The party challenging validity in court is likely to still have the ultimate burden of proving in court that the patent claims are not valid, as either anticipated or obvious in view of the prior art.

The approach during examination by the USPTO, whether of an original application, a reissue application or a patent subject to *ex parte* or *inter partes* reexamination, is different. The Examination Guidelines published in the MPEP § 2141 *et seq.* acknowledge that the guidelines are not substantive rule making and, thus, reflect a preferred approach to be taken by Examiners under the most recent guidance from the U.S. Supreme Court in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). The MPEP § 2142 explains the legal concept of “*prima facie* obviousness” that allocates who has the burden of going forward with production of evidence in each step of the examination process. The USPTO has the burden at first, and must make its case by a preponderance of the evidence and a clear articulation of the reasons why the claimed invention would have been obvious based on any of seven or more rationales, consistent with the decision in *KSR*. As provided in MPEP § 2145, if the Examiner establishes a *prima facie* case of obviousness, the burden shifts to the applicant to come forward with arguments and/or evidence to rebut the *prima facie* case. According to decisions of the USPTO Board of Patent Appeals and Interferences, evidence in the form of declarations of the inventors or experts provides the strongest basis for rebutting the Examiner’s position and placing the burden of coming forward back on the Examiner.

31. Is divergence in approach to inventive step / non-obviousness between the courts and the patent granting authority in your jurisdiction problematic?

At a minimum, the higher “clear and convincing” standard in the courts for proving obviousness will tend to encourage challengers to seek review of issued patents through the reexamination process, where the standard is only a “preponderance of the evidence.” Moreover, the USPTO will give claims their broadest reasonable interpretation in applying prior art, as contrasted to a more rigid and potentially narrow claim construction in the courts that tends to favor validity.

Regional and national patent granting authorities

32. If you have two patent granting authorities covering your jurisdiction, do they diverge in their approach to inventive step / non-obviousness?

There is only one patent granting authority in the U.S.

33. If yes, is this problematic?

Not applicable.

II. Proposals for harmonization

The Groups are invited to put forward proposals for the adoption of harmonised rules in relation to the patentability criteria for inventive step / non-obviousness. More specifically, the Groups are invited to answer the following questions without regard to their national laws:

34. Is harmonization of inventive step / non-obviousness desirable?

In general, a harmonized approach to a determination of inventive step and obviousness is desirable from several perspectives. First, it provides an important measure of uniformity that leads to greater predictability for both patent holders and the public. Second, it leads to greatly reduced costs in prosecution both for applicants and for Offices, as it enhances the ability for work sharing.

34. Is it possible to find a standard for inventive step / non-obviousness that would be universally acceptable?

A universally accepted standard is a worthy, but probably unattainable goal due to numerous ancillary issues that must be resolved. Recent international harmonization initiatives within the Group B+ discussions were unable to agree on whether a definition of obviousness/inventive step should consider “the differences and similarities between the claimed invention and” the prior art. This impasse reflected fundamentally different approaches to invention, based on “problem-solution” on one hand and the *Graham v. Deere* standards on the other. In addition, the ancillary issues involving the definition of what exactly is “prior art” to be considered in the analysis, whether secret prior art may be considered, and whether self collision issues should be considered. Nonetheless, significant advances toward harmonization on this issue would be of great benefit to Offices and users alike.

36. Please propose a definition for inventive step / non-obviousness that you would consider to be broadly acceptable.

A claimed invention shall involve an inventive step (shall not be obvious) if, having regard to the applicable prior art, the claimed invention as a whole would not have been obvious to a person skilled in the art at the priority date of the claimed invention.

37. Please propose an approach to the application of this definition that could be used by examiners and by courts in determining inventive step / non-obviousness.

An approach that could be used by Examiners and Courts when determining the existence of an inventive step is (1) first, interpret the claim on the basis of the teachings in the specification and drawings, other claims and the knowledge of one skilled in the art

at the time of the priority date, (2) second, identify what is the applicable prior art, based on the priority date, (3) third, identify the teachings of the applicable prior art as would be understood by one skilled in the art at the priority date, (4) fourth, identify the differences between the interpreted claims and the prior art, (5) fifth, determine whether the differences would make the invention as a whole obvious to one skilled in the art at the priority date, and (6) finally, give due consideration to evidence of secondary factors, such as, but not limited to, commercial success of products due to the invention, licensing due to the invention and recognition in the art due to the invention.

Summary:

In the United States, the approach used when determining obviousness is to: (1) interpret the claim based on the specification and the knowledge of a person of ordinary skill in the art at the time of the priority date, (2) identify the applicable prior art, (3) identify the teachings of the applicable prior art as would be understood by a skilled person, (4) identify the differences between the interpreted claims and the prior art, (5) determine whether the differences would make the invention as a whole obvious to a skilled person at the time the invention was made or at the priority date, and (6) give due consideration to evidence of secondary factors, such as, but not limited to, commercial success, long-felt but unsolved needs, the failure of others, and unexpected results achieved by the claimed invention. To combine teachings from several prior art references, there must be some reason or motivation to combine the teachings in a way that renders the claim obvious without the use of hindsight. In litigation, there is a heightened standard of proof required for obviousness due to the presumption of validity owed a granted patent.